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RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE  
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* SHUNPEI YAMAZAKI

Appeal 2010-002033  
Application 10/045,902  
Technology Center 2800

Oral Hearing Held: September 14, 2010

Before JAMES T. MOORE and ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judges*, and LINDA E. HORNER, RICHARD E. SCHAFER, ADRIENE LEPIANE HANLON, JENNIFER D. BAHR and MARC S. HOFF, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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1           The above-entitled matter came on for hearing on Tuesday,  
2     September 14, 2010, commencing at 9:00 a.m., at the U.S. Patent and  
3     Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah  
4     Rinaldo, Notary Public.

5     MR. ROBINSON: Good morning, Your Honors.

6     JUDGE MOORE: Good morning. You may begin at any time. We have  
7     obviously an expanded panel here. So we're going to give you a little more  
8     time than normal. We're going to mark you for a half hour from now and  
9     you may begin at any time.

10    MR. ROBINSON: Thank you, Your Honor. Additionally, let me express  
11    my appreciation to the Board for rescheduling this hearing. I think we were  
12    scheduled in August and I had an unusual vacation scheduled. So I do  
13    appreciate your accommodation, particularly since I didn't realize it was an  
14    expanded panel and the need to reschedule so many people's schedules is  
15    appreciated.

16    JUDGE MOORE: It's not a problem.

17    MR. ROBINSON: The case we have before us today is directed to what  
18    constitutes an error under 35 USC 251 that can be corrected by reissue.  
19    The facts of the case that are set forth in the Appeal Brief, are probably  
20    worthy of a brief review as I'm sure that you have looked at them closely.  
21    In the subject case, the '991 patent that is at issue included a terminal  
22    disclaimer that was filed during the prosecution of the patent.  
23    Twenty-one months prior to the issuance of that patent we prepared and filed  
24    a petition under rule 182 asking that that terminal disclaimer be withdrawn  
25    and we set forth reasons in that petition for why we felt that the claims had  
26    been amended so that the terminal disclaimer was no longer necessary.

1 That petition was never acted on. The case before us today effectively  
2 presents the question as to whether the failure to act on that petition or our  
3 failure in not taking any number of additional steps prior to the issuance of  
4 that patent is a sufficient error that can be corrected under 251.

5 One of the important distinctions that we think we've highlighted in our  
6 briefs is that we are not here today suggesting that we filed a terminal  
7 disclaimer and we don't like that result anymore and we want it out now.

8 That's not what happened in the case. Our error is not that we filed a  
9 terminal disclaimer that was inappropriate.

10 The error is focused on this petition that was filed and the fact that either the  
11 office or our office -- and we've fallen on the sword here -- did not pay close  
12 enough attention that this petition was in the case and do something to get it  
13 acted on.

14 We did file the petition. We did highlight it in the remarks of the  
15 amendment at the time to the examiner and then that's it. Nothing else  
16 happened until the case issued.

17 JUDGE MOORE: What were your options at that point in time?

18 MR. ROBINSON: Well, that is a good question because we've confronted  
19 this before. There are probably some options under rule 313 to withdraw  
20 this case. I'm not exactly sure which of the categories we could have fallen  
21 into there but we may have been able to withdraw the case to get the petition  
22 to be decided.

23 Certainly if we had sufficient time prior to the issuance of the case, we could  
24 have called petitions, we could have called the Examiner, we could have  
25 said, What's going on with our petition? Why hasn't it been acted on?

26 In cases such as this we could call the director's office and say, We've got an

1 issue; you don't want to issue this case yet. In most cases sua sponte  
2 withdraw the case because it wasn't in good form.  
3 So I think there were things that could be done. And in footnote 4 of our  
4 Appeal Brief where we set forth a number of errors, we highlight some of  
5 those, one, not withdrawing it under 313 before or after payment of the issue  
6 fee. Not deferring it. I understand we could have deferred issuance under  
7 314 until the petition to withdraw was considered.

8 So there were certainly options like that that we feel may have been  
9 available to us and some of these, when we were preparing our Brief and  
10 preparing this reissue application these were questions that were presented to  
11 us and one of the reasons why we have highlighted all of these errors.  
12 People ask why you didn't do this; we said that was another error we made.  
13 So that's why they are here.

14 JUDGE MOORE: Fair enough.

15 MR. ROBINSON: The CAFC and CCPA tell us that 251 is grounded in  
16 fairness and equity. It's an equitable relief and it should be construed  
17 liberally. We think that's very helpful in this case to our position.  
18 Effectively, we feel that the guidance in from the CAFC should generally be  
19 construed as if there's no reason why the error is not permitted to be  
20 corrected, then the default should fall to correcting it. It is almost a burden  
21 of proof issue and I don't have a case on point where I can tell you the  
22 CAFC said that other than fairness in equity and construe this provision  
23 liberally.

24 The delays in this case, we have talked about them in our Brief at length. It's  
25 been years. We had an interview with Examiner Potter. We thought we had  
26 an interview summary that said, okay, this is an issue based on the

1 Durckheimer case which Judge Hanlon, I think you were a part of.  
2 We said that this is a type of error that can be corrected. Two years later we  
3 got another non-final office action. So we've had a lot of delays. The  
4 unexpired part of the patent that's going to be left if we ultimately prevail in  
5 this case is shrinking quickly.  
6 So in addition to the fairness in equity issues, although not directly on point,  
7 there has been extraordinary delay in this case.  
8 I mentioned the Durckheimer decision. The Durckheimer decision, we  
9 think, is the right result, of course, because it reached a conclusion that's  
10 beneficial to our case here. We feel we are more favorable than  
11 Durckheimer because we took action before the patent issued. We filed our  
12 petition to withdraw, asked for the terminal disclaimer to be removed.  
13 We think that's helpful because it helps put the public on notice that we  
14 didn't freely dedicate this portion. If the public is reviewing the file history  
15 and looking at what's in there, they should see from that that we didn't give  
16 up on this. It wasn't our intent, it wasn't freely dedicated.  
17 I will admit that we are slightly weaker than the Durckheimer decision in  
18 that our claims were amended in a way such that we feel the terminal  
19 disclaimer isn't necessary. Whereas, in Durckheimer the claims themselves  
20 were cancelled.  
21 Now, I could make a lot of legal arguments to you that amending a claim is  
22 effectively canceling the underlying claim and presenting a new claim, but  
23 in the end the Durckheimer decision and the facts in that case perhaps are  
24 slightly more favorable in that regard.  
25 Nevertheless, we feel that following the procedures, which -- and this is

1 important. This is what we did. The MPEP 1490 tells us that if you have a  
2 terminal disclaimer that's in the case before the case issues, then file a  
3 petition under 182 and that's the remedy. That's the procedure. That's what  
4 we're told to do and we tried to do that.

5 We messed up. We made an error. That's the issue here in not making sure  
6 that we got that petition properly acted on before the case issued.

7 JUDGE HORNER: Hasn't your patent expired now?

8 MR. ROBINSON: I don't believe so. It's a great question and it's point one  
9 of the Durckheimer decision and also in the MPEP 1490 what is the term of  
10 the patent, the unexpired portion of the term.

11 So the answer to your question is, yes, if the terminal disclaimer is not  
12 withdrawn, then the patent is expired. If the terminal disclaimer is  
13 withdrawn, there is an unexpired portion of the term.

14 JUDGE HORNER: But when is the term set? Is it set at the date of issue?

15 MR. ROBINSON: I think so, yes.

16 JUDGE HORNER: And at the date of issue, your terminal disclaimer had  
17 not been withdrawn. So would the term have expired in 2003?

18 MR. ROBINSON: Well, let me argue that -- I'll say no to that but I think we  
19 have to peel the layer back a little bit further because it is an important issue  
20 about what is the term and what does 35 USC 251 mean when it says the  
21 unexpired portion of the term, if I have got the words right.

22 We say the expiration date of our patent is January 30, 2018, and I think  
23 that's the 17-year date. The terminal disclaimer doesn't change the term of  
24 the patent. That's point one of the Durckheimer decision. It doesn't change  
25 the term. It simply disclaims a portion of the term. So we're not changing  
26 the term of the underlying patent.

1 JUDGE HORNER: Are you aware of any Federal Circuit cases that support  
2 that?

3 MR. ROBINSON: No, I'm not off the top of my head. I would have to read  
4 back through -- I don't know that we specifically researched that issue and  
5 I'm thinking through the cases I read yesterday, I don't know that I saw that  
6 particular issue. So I'm not aware of that.

7 So the answer to your question is, is our patent expired? I guess I would say  
8 it depends on whether or not we're successful here today. And a similar  
9 issue may have applied in Durckheimer. I haven't checked the exact dates  
10 here, but perhaps their patent wasn't expired.

11 JUDGE HORNER: It expired in '96 and the Durckheimer decision issued in  
12 '94.

13 MR. ROBINSON: Okay. And if there's one point that we certainly have  
14 stressed and we think is important, it's the fact that we filed this petition  
15 before the patent issued.

16 And there's been a lot of discussion about the Durckheimer unique facts and  
17 circumstances, top of page 21. Now, initially that paragraph appears to be  
18 focusing primarily on the question you just asked about the term, and it's  
19 kind of slightly taken out of context but it seems to be focusing on that first  
20 factor, the term.

21 But in our particular case, we also feel we have unique facts and  
22 circumstances. They are different than Durckheimer but we think they are  
23 more favorable. We've tried to take this action. So that's important to us to  
24 stress that.



1 JUDGE MOORE: Can I recast the question just a little bit? If I'm a  
2 competitor, for sake of argument, and I'm looking at your patent, do I have  
3 the right to practice the invention now or not?

4 MR. ROBINSON: Let me think about that. So if you are a competitor and  
5 you come to me and ask me, based on this history, do I have the right to  
6 practice this patent or not, I would probably advise you no.

7 JUDGE MOORE: Well, what would one just looking at the file without  
8 your opinion in terms of representing your client -- I'm thinking how would  
9 their attorney advise them?

10 MR. ROBINSON: I'm not certain about that. I'm trying to put it in context  
11 that allows me to think about the issues clearly and I feel that when I would  
12 look or when they would look at the final history of this case and look at the  
13 reissue proceeding that's pending, they would see that, you know, this  
14 terminal disclaimer is being questioned, it's being challenged and it -- you  
15 know, there's an argument for why it shouldn't be maintained in this case.

16 JUDGE MOORE: So I couldn't just look at the issue date, there's a terminal  
17 disclaimer in there and say this patent is not of concern until something  
18 happens otherwise?

19 MR. ROBINSON: No, I don't think that would be wise for you to do. And I  
20 think that the general feeling that I have always carried with me through my  
21 practice of patent law is that the patent is a marker for what happened in the  
22 prosecution history.

23 And we look at the prosecution history regularly for claim interpretation  
24 issues, for estoppel issues, for IDS issues and certainly with respect to why  
25 or the reasons terminal disclaimer were filed.

1 So I don't feel that anyone that's going to be looking for a reason of whether  
2 they can or cannot practice an invention should rely solely on looking at the  
3 patent or the face of the patent.

4 JUDGE MOORE: For the term? Not for claim interpretation, just for the  
5 length and duration of the claim?

6 MR. ROBINSON: Again, Your Honor, I'm going to say no to that. I  
7 understand your point and I look at the face of a patent and the term  
8 calculations these days can be confusing, depending on whether it's extended  
9 in 1995 and the reason for the terminal disclaimer and whether it was the  
10 result of a CPA or various other things.

11 But typically you've got to look deeper than that and you've got to say if  
12 there is a terminal disclaimer here and certainly if you are looking at  
13 something as significant as am I free to practice what's in this patent, you are  
14 going to look at that prosecution history and you are going to see why was  
15 this terminal disclaimer filed.

16 At that point I feel it opens up. The public then sees that there's this petition  
17 and there's more to that issue.

18 JUDGE SCHAFER: So you are saying your position is there are no  
19 intervening rights under section 253 for the period between 2003 and  
20 whatever the effect on the patent was. So let's say you get your reissued  
21 patent.

22 MR. ROBINSON: I would have to say that the issue of whether or not the  
23 intervening rights are going to apply is not -- I don't think I have focused on  
24 that close enough, Your Honor, to give you an answer as to which way I  
25 would go on that.

1 So the intervening rights issue hasn't been presented yet, so I would have to  
2 look more closely before I would say yes or no on that. Unfortunately, I  
3 can't answer that.

4 JUDGE MACDONALD: On a slightly different issue, in your Brief you are  
5 asking for specific relief in the last paragraph and I'm not certain what you  
6 are referring to there.

7 You are requesting that the petition under 182 be -- to withdraw should be  
8 granted. I'm not certain what petition you are referring to since you don't  
9 have a date there to indicate. Is this the petition in the original prosecution  
10 that resulted in the patent or some other petition that I haven't been able to  
11 find in the record?

12 MR. ROBINSON: Well, I think reading this in context, what this is  
13 intended to refer to is the petition in the original patent which has been  
14 dismissed.

15 JUDGE MACDONALD: Under what authority would we be able to take  
16 that action even if we agree with you?

17 MR. ROBINSON: I'm not sure that the first part of that, that the petition  
18 under that should be granted is relief that you can grant. The second part,  
19 that terminal disclaimer should be withdrawn in the face of the patent  
20 corrected, I believe, is something that you could grant.

21 JUDGE MACDONALD: Actually, I don't agree because this is a  
22 petitionable matter. So again, where is the petition that's supposed to do this  
23 correction? Because your oath specifically states all errors corrected in this  
24 reissue, yet I'm not finding any correction. I see the list of errors but I don't  
25 see the steps to correct any of that.

1 MR. ROBINSON: Yeah, I think the answer to that question is that we feel  
2 we haven't gotten past the hurdle yet as to a threshold question as to whether  
3 or not the errors are correctable.

4 JUDGE MACDONALD: Doesn't that threshold include actually starting the  
5 correction process?

6 MR. ROBINSON: Well, it was our belief that the correction by the reissue  
7 process would not necessarily require that we file a new petition under 182  
8 in the reissue.

9 JUDGE MACDONALD: Didn't the Director do a final decision of your  
10 request for reconsideration of the original petition?

11 MR. ROBINSON: I would have to check and make sure it says "final," but I  
12 believe it may or may not say this is a final agency action. I would have to  
13 check to confirm that.

14 JUDGE MACDONALD: And also I think the MPEP is pretty clear that the  
15 reissue oath must allege and the reissue application must provide correction  
16 of the error. And I don't see that there's any provision here for correcting the  
17 error.

18 MR. ROBINSON: So the first part of that, the reissue of -- first of all, let  
19 me say that I'm familiar that we often go through an iterative process with  
20 reissuance until we come up with language that works. Certainly in the  
21 Durckheimer decision, I also see that the Board put in a new rejection  
22 saying, hey, the reissue oath isn't good enough.

23 So for that I'm prepared to say that if the words aren't exactly where they  
24 need to be on the reissue oath, we can work with that and submit  
25 supplementals. That's the first half of that.

1 The second half is that it was my general understanding that through the  
2 reissue process in correcting the error in this case we would simply be  
3 asking for the Patent Office to make a record that the terminal disclaimer is  
4 withdrawn.

5 I don't know, again, what was done in Durckheimer --

6 JUDGE MACDONALD: Petition was filed.

7 MR. ROBINSON: And, you know, I would assume in this case a petition  
8 can be filed as well. I mean, I don't know if it can be done after this or if  
9 there's an order of events issue.

10 JUDGE MACDONALD: You've already indicated, I believe, in  
11 Durckheimer there was agreement that the terminal disclaimer was no longer  
12 effective in the sense the claims were gone that that was about. So I can  
13 sense the Examiner and the Appellant had both agreed on the issue there but  
14 I don't see that kind of agreement in here. It strikes me that the petition  
15 would need to be processed. Otherwise any decision we're doing is just  
16 advisory.

17 MR. ROBINSON: Well, my feeling on that in part and I think the concern  
18 is there in the back of my mind, which is whether or not this is an issue that  
19 can be corrected under 251, should this terminal disclaimer be withdrawn.

20 JUDGE MACDONALD: Isn't that a step too far? Isn't the real first step  
21 really the merits of the petition, which in Durckheimer were expressed in the  
22 record, the merits of if a petition was filed?

23 Here we have nothing to indicate that the Director would agree that the  
24 amendment is of the type that would not have resulted in a double patent  
25 rejection.

1 MR. ROBINSON: That's right and we also have nothing that indicates that  
2 a double patenting rejection would be maintained. The prosecution history,  
3 even in this reissue application which should be complete and should, I  
4 believe, have looked at those issues and said even if there is an error here  
5 and it is correctable by reissue, nevertheless, double patenting would still  
6 apply based on the claims.

7 That's never been raised. The issue hasn't been brought up by the  
8 Examiner --

9 JUDGE MACDONALD: Without the petition and without the withdrawal  
10 of the terminal disclaimer, why would that be appropriate for the Examiner  
11 to raise those issues? As it stands, there is a terminal disclaimer and those  
12 are not appropriate rejections.

13 MR. ROBINSON: I'm sorry, as it stands now?

14 JUDGE MACDONALD: There is an effective terminal disclaimer as it  
15 stands right now. Therefore, double patenting was not an issue. So why  
16 would the Examiner do a hypothetical rejection?

17 MR. ROBINSON: Well, I think that, with all due respect, when the basis  
18 for the reissue is to withdraw the terminal disclaimer, then the fact that  
19 there's a terminal disclaimer that obviates those rejections gets a little  
20 circular and I feel that the Examiner would appreciate that if this error is  
21 correctable under 251, that the terminal disclaimer therefore is no longer  
22 necessary is the ultimate question that we're reaching.

23 Now, we did indicate in our Brief several times that we've never reached that  
24 issue, that the Patent Office hasn't yet said the terminal disclaimer is  
25 necessary or not because we feel we have been roadblocked by this

1 procedural matter of it doesn't matter because it's not an error you can  
2 correct under 251.

3 JUDGE SCHAFFER: Does your original petition explain why there was no  
4 double patenting rejection, why the terminal disclaimer was no longer  
5 necessary on the merits of the invention?

6 MR. ROBINSON: It did. It didn't go into great detail, but it did explain it.

7 JUDGE SCHAFFER: And that was never ruled on either, I take it?

8 MR. ROBINSON: It wasn't substantively ruled on. It was dismissed based  
9 on the fact that it was filed after the patent issued.

10 JUDGE SCHAFFER: Right. But there's never been a ruling by an Examiner  
11 or other Office official that there was no longer a double patenting issue?

12 MR. ROBINSON: That is correct. And the petition I'm looking at here  
13 discusses that at least the lower limit of the carbon concentration is one of  
14 the distinguishing features over the claims of the patent that is the basis of  
15 the double patenting rejection.

16 JUDGE SCHAFFER: And it was argued that that would be an unobvious  
17 distinction?

18 MR. ROBINSON: I would not necessarily say that it was argued in detail.  
19 It was pointed out that they are different for that reason and we feel that the  
20 double patenting is no longer applicable.

21 The petition, it's attached, I'm sure you've seen it but it's only a couple of  
22 paragraphs. It's very short and simply makes those assertions that the double  
23 patenting isn't necessary. We didn't do a detailed analysis of comparing  
24 claim limitations and going through that process.

25 Again, generally if there is no disagreement with that particular issue, then I  
26 don't write long, detailed arguments until we have refined the issues.

1 So Judge MacDonald, I understand, you know, your comments there with  
2 respect to there not being a petition in this case. My gut tells me run back  
3 today and file a petition, but I don't think that's going to get us where we  
4 need to be. I want to say I believe it's a little form over substance with all  
5 respect to you.

6 JUDGE MACDONALD: I'm more concerned with the issue that we are not  
7 the proper place to be with this issue before the Director.

8 MR. ROBINSON: And thank you for mentioning that because we didn't  
9 appeal this reissue without asking that question and it's been a long time but  
10 my recollection is that I spent some time trying to find out, do I appeal this  
11 or do I petition this?

12 And the conclusion I reached at the time in part because of Durckheimer,  
13 which may be slightly different now, I'm appreciating, was this was an  
14 appealable issue.

15 I continued today -- on my way down here today I was thinking about that  
16 issue. I continue to believe this isn't so much a procedural issue as a  
17 question fundamentally of what's error under 251, and the decision about  
18 whether it's an error or not and error, I feel, lies here with this tribunal and  
19 perhaps not as a petitionable matter.

20 So I share your concern. I know I looked into that before and reached the  
21 conclusion and probably based on discussions with Patent Office personnel  
22 that we should appeal this, and I still feel on balance that it's the right place  
23 to be.

24 So I would like to go through, I think we've touched on all of them  
25 somewhat during the questioning there but I'd like to briefly discuss the  
26 Durckheimer decision and the three factors that were set forth in there.



1 Effectively Durckheimer looks at MPEP 1490. And MPEP 1490 discusses  
2 withdrawals of terminal disclaimers and there's three concerns set forth in  
3 the MPEP that Durckheimer addresses.

4 And the first, as Judge Horner was discussing, is would this extend the term  
5 of a patent? And I think our position on this is paralleling to what was in  
6 Durckheimer was agreed to there which is that the terminal disclaimer  
7 doesn't change the term. It simply disclaims a portion of the term that's  
8 there. So we're not changing the term. We're simply removing a disclaimer  
9 with respect to a portion of the term.

10 That was the reason that Durckheimer concluded that this provision didn't  
11 apply. We think that's applicable here as well.

12 JUDGE MOORE: As a practical matter though, I asked this question  
13 previously, if I'm making these semiconductors and I don't think you are  
14 going to be able to enforce this patent against me, how is withdrawing that  
15 terminal disclaimer not bringing the term out over what I'm doing then,  
16 extending it to cover what I'm presently doing? Temporal extension, as it  
17 were, of the claims.

18 MR. ROBINSON: The question on that is, and I think you are struggling  
19 with this and I believe I understand it, which is what is the term of this  
20 patent? And it took me a while in reading Durckheimer, the term of the  
21 patent extends to 2018 but we've disclaimed a portion of that.  
22 So I think it becomes circular as to whether or not if the terminal disclaimer  
23 is proper, then the patent is expired; if the terminal disclaimer is not proper,  
24 then it's not expired. The term never changes.

25 JUDGE MOORE: When you say "proper," you are talking about legal  
26 sufficiency? Are the words not good or --

1 MR. ROBINSON: No. I'm talking about whether or not there's a sufficient  
2 error here that allows a terminal disclaimer to be taken back and be  
3 corrected.

4 But let's not talk about expiration of the patent. Perhaps I misspoke there  
5 because the patent isn't necessarily expired as much as it's subject to a  
6 terminal disclaimer. It's disclaimed and there's a difference between a patent  
7 expiring because its term ends and it being disclaimed, a portion of its term  
8 being disclaimed.

9 JUDGE HORNER: So the patent -- in a situation where you've got a  
10 terminal disclaimer that's proper, the patent would expire on that date to  
11 which the term has been disclaimed?

12 MR. ROBINSON: That is another question I'm not going to be able to  
13 answer. I'm going to have to go back and look at that but I don't believe the  
14 term of the patent would necessarily end. The patent would no longer be  
15 enforceable.

16 I would have to research the term since obviousness double patenting is  
17 judicially created, I don't know if we'll find that in the statute. So I think,  
18 Your Honor, I could make a reasonable argument that the patent isn't  
19 expired but it is disclaimed.

20 And some of this takes us back to Altoona years ago where it's a different  
21 form of disclaimer that was in place in that case and the laws were different  
22 at that time, but I feel there's a difference between disclaiming a portion of a  
23 term and the term expiring. I can't answer your question any more precisely.  
24 It's a good question.

25 JUDGE HORNER: It seems to me like in Durckheimer the panel was  
26 interpreting the word "term" in 251 but didn't focus on the unexpired part

1 language of 251 because they were deciding the case in '94 and even with  
2 the terminal disclaimer the patent wouldn't have expired until '96. So they  
3 weren't focused on the unexpired part of 251, that language.

4 And if we look at Morgan, Morgan pretty clearly says once the patent  
5 expires, even if it's during the reissue proceeding, the office no longer has  
6 any authority under 251 to reissue a patent.

7 MR. ROBINSON: If the patent expires based on the end of its term is where  
8 I believe Morgan is.

9 JUDGE HORNER: So the question is whether or not this patent has expired  
10 by virtue of its terminal disclaimer because we cannot go beyond -- we  
11 cannot reissue except for the unexpired part for the term.

12 MR. ROBINSON: Yes, the unexpired part of the term, though. And Your  
13 Honor, I would offer that the unexpired part is modifying the expression  
14 "term" there.

15 So a patent has a term and if we look at the US code that focuses on the term  
16 which, as Durckheimer says, with we read these in harmony, we read them  
17 as one, there's a term that's going to be ascribed to the subject '991 patent  
18 and then we have a terminal disclaimer that disclaims a portion of that term.  
19 So I would continue to assert that we have an unexpired part of the term  
20 because we can look at what the term is, we can determine whether or not a  
21 portion of that term is expired or unexpired separate and apart from a  
22 terminal disclaimer and then look at the issue that the terminal disclaimer  
23 simply disclaims a portion of that.

24 Do you want me to give you a moment to look it up?

25 JUDGE HORNER: No, no, that's fine.

1 MR. ROBINSON: The second issue that was in MPEP 1490 and in  
2 Durckheimer, Judge Moore, is I think what you are touching on which is  
3 how the public going to be protected here? What is the recapture doctrine  
4 focusing on here?  
5 One of the keywords that we've highlighted is we can't take back something  
6 intentionally dedicated to the public. And we feel that the filing of our  
7 petition in the application that was pending before issuance in the '991  
8 patent is pretty strong evidence that we didn't intend to dedicate this. We  
9 think that negates the intent.

10 I commented earlier that I feel that it's reasonable for people that are looking  
11 at this case to review the file history. They'll see this. They'll see this  
12 reissue proceeding and be aware of what arguments are being made and  
13 recognize that there is an argument that this patent is going to have a longer  
14 enforceable period than what is shown on its face.

15 JUDGE HOFF: Counsel, in the absence of a granted petition, the terminal  
16 disclaimer is enforced, correct?

17 MR. ROBINSON: In this particular case?

18 JUDGE HOFF: Currently, yes. The petition has not yet been granted. So  
19 the terminal disclaimer is currently in force. So currently there is something  
20 that has been dedicated to the public; is that correct?

21 MR. ROBINSON: I think the terminal disclaimer is -- I think I can agree  
22 that it's in force. I want to take issue with the dedicated with the public.  
23 Part of the touchstone there is freely dedicated to the public and we didn't  
24 freely dedicate this to the public.

25 At the time the terminal disclaimer was filed, we said, okay, this is it and  
26 then -- I can tell you, this case is a learning experience for me. I never file

1 terminal disclaimers anymore. Simply have language that says, We request  
2 double patenting rejection be held in abeyance until such time as allowable  
3 subject matter is indicated.

4 That's what we say because we don't want to be in this situation again. And  
5 we wait until it's the last thing, the very last thing that's there to file that  
6 terminal disclaimer.

7 But I think it's important here the freely dedicated. It was freely dedicated  
8 when we -- I'm sorry, go ahead.

9 JUDGE HOFF: Well, the double patenting rejection was made and you  
10 were presented with a situation that, okay, there's something I have to do in  
11 order to get my patent issued.

12 So are you saying that essentially you filed a terminal disclaimer under  
13 protest? Is there some record that, yes, I'll file this disclaimer under duress?

14 MR. ROBINSON: Here in this case, no.

15 JUDGE HOFF: But that's essentially the mental process that you are  
16 suggesting?

17 MR. ROBINSON: No. I'm suggesting that to timely file the disclaimer it  
18 was, I don't want to say proper, but it was intended. But subsequent to that,  
19 because of other rejections, the claims were amended.

20 JUDGE HOFF: I understand. So you filed this petition to withdraw the  
21 terminal disclaimer but at the time you filed the petition, you knew that it  
22 was not a guarantee that any petition would be granted.

23 MR. ROBINSON: We can never be certain that any petition will be granted,  
24 yes.

1 JUDGE HOFF: So what I'm suggesting is that you don't necessarily know,  
2 you can't say for a fact that -- I lost my train of thought. That something  
3 would not be dedicated to the public.

4 MR. ROBINSON: Right. To the extent -- if I understand your question, to  
5 the extent that I think it's coming back to whether or not the terminal  
6 disclaimer or the obviousness type double patenting, ODP in this case, is  
7 proper or not, we haven't really reached that issue.

8 No one, the Examiner in the reissue, the Director below on the petition, no  
9 one's looked at this and said, Oh, yeah, there should be double patenting or  
10 there shouldn't.

11 To the extent that we reverse the Examiner here with respect to the issue of  
12 this is an error that can be corrected under reissue, then I think this case goes  
13 back to Examiner Potter or whoever is handling it now to look at: Okay,  
14 since this can be corrected, is it appropriate to correct it?

15 I don't know that we've reached that issue and I think the -- my feeling here  
16 is that we're not making a determination as to whether or not this patent  
17 reissues or doesn't reissue. We're making a determination as to whether this  
18 is a type of error that can be corrected under reissue. And then I'll get the  
19 pleasure of working with whatever subsequent rejections or issues may be  
20 raised with respect to that concern.

21 JUDGE HORNER: Not to beat a dead horse, but let's go back to that term  
22 question one more time. In Durckheimer the panel looked at the definition  
23 in section 154 of the statute that describes the term of the patent and it's  
24 been -- 154 has been amended since Durckheimer to deal with patent term  
25 adjustment.

1 And one of the sections now under 154 deals with disclaimed term and it's  
2 talking about patent term adjustment but it says, "No patent, the term of  
3 which has been disclaimed beyond a specified date, may be adjusted under  
4 this section beyond the expiration date specified in the disclaimer."

5 So wouldn't we read that in this revised version of 154 to mean that when  
6 you file a terminal disclaimer you are resetting the expiration date?

7 MR. ROBINSON: Isn't that portion -- and again, I apologize, I didn't bring  
8 the code with me. Isn't that portion, as you said, directed to patent term  
9 extension and refers to any patent whose term is extended under this section  
10 shall not be extended beyond the period of the disclaimer?

11 JUDGE HORNER: Yes, the section would be 154, right? This is all part of  
12 154.

13 MR. ROBINSON: It's not 154A, B, C or something of that, which is where  
14 the sections may come in? Because it's my understanding that what that's  
15 directed to is the 4414 rule, if I have it right, concerning delays and PTA that  
16 comes into play, that we can't take patent term extension and use it to get  
17 beyond what we would file with respect to a disclaimer. That's my  
18 understanding of that section.

19 JUDGE HORNER: I agree. I guess the only point I'm raising here is that it  
20 at least seems to give us an insight in terms of the statute when something is  
21 disclaimed. They are considering the term of the patent to be the expiration  
22 date specified in the disclaimer is the term set by -- at the time of issuance of  
23 that patent. So the term is not 2018. Under this it would be 2003.

24 MR. ROBINSON: I'm sorry, could I read it or could you say it again? May  
25 I approach?

26 JUDGE HORNER: Yes. It's this section right here on disclaimer.

1 MR. ROBINSON: Okay. I see --

2 JUDGE HORNER: The panel in Durckheimer didn't have that language  
3 when they were interpreting 154. So what do we do with that language?

4 MR. ROBINSON: Well, I think what you do with that language is limit that  
5 to the intended application of under this section and patent term adjustment.  
6 So this is 154. It's fairly deep in here. It appears to be little b, 2, big B.  
7 So I think that when we go back to the section, this is focusing on patent  
8 term adjustment. But I see your point and I think perhaps the language of  
9 expiration date in this wasn't precisely chosen by Congress but I don't think  
10 they would have appreciated the issues that we are discussing today. They  
11 are somewhat complex.

12 JUDGE HORNER: We are sort of stuck with whatever language they pick.  
13 We can't look behind it and change the wording of the statute.

14 MR. ROBINSON: No, we can't change the wording of the statute but we  
15 can clearly interpret the statute to be limited to patent term adjustment which  
16 is where the statute is focused on and not in the situation such as this.  
17 We're not arguing today that there was a delay that allowed us to get an  
18 adjustment beyond that period. What we're focusing on is 251 and the error  
19 issue, of course.

20 JUDGE MOORE: I'm pretty sure we understand your points and we are  
21 running a bit over our promised time. I'll give you a couple minutes to wrap  
22 up if you want.

23 MR. ROBINSON: I'm fairly comfortable that you do understand the points  
24 as well. The only last point I would like to make, and I will try to keep this  
25 to 30 seconds, is the third point in Durckheimer which is that -- and this is  
26 what we circle back to.



1 We don't feel we're challenging a terminal disclaimer here. The error isn't  
2 that we filed the terminal disclaimer and we're unhappy with the result.  
3 We're challenging the petition issue.  
4 And I appreciate the difficulties with that but we're challenging that the  
5 petition wasn't acted on and the errors that occurred both at the Office and at  
6 our end in not addressing that issue. So I can quit at that point.  
7 JUDGE MOORE: Thank you counsel for a well-prepared and well-argued  
8 argument.

9 Whereupon, the proceedings at 9:39 a.m., were concluded.